REMARKS

Claims 27 – 30, 33 – 39, 41 – 43, 45 and 46 are pending in this application. Claims 27, 33 and 42 were rejected under the judicially created doctrine of obviousness-type double patenting. Claims 27 – 30, 33 – 39, 41 – 43, 45 and 46 were rejected under 35 USC § 103 over Forman (US 5826588) in view of Mareiro et al. (US 6258099, hereinafter Mareiro).

By this amendment, claim 30 is amended. Reconsideration in view of the above amendment and the following remarks is respectfully requested.

Claim Rejections based on obviousness type double patenting

The Office Action rejects claims 27, 33 and 42 under the judicially created doctrine of obviousness type double patenting over claims 1, 6, 12 and 13 of US 6193738. This rejection is respectfully traversed.

Applicants assert that US 6193738 may not be used as a reference against the immediate application.

> A patent issuing on an application with respect to which a requirement for restriction under this section has been made...shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application...if the divisional application is filed before the issuance of the patent on the other application. 35 USC § 121.

The immediate application is a divisional application filed as a result of a restriction required by the USPTO during prosecution of US 6193738, which was filed before the issuance of US 6193738. A copy of the restriction requirement is attached hereto.

Further, claims 1, 6, 12 and 13 of US 6193738 were included in Group I of the restriction requirement. Claim 27 of the present application, directed to a medical balloon, was included in Group II of the restriction requirement. Claims 33 and 42 of the present application, added during prosecution, are also directed to medical balloons. Thus, the claims of the present application are patentably distinct from the claims of US 6193738.

Accordingly, Applicants request withdrawal of the rejection under the judicially created doctrine of obviousness type double patenting.

Claim Rejecti ns

The Office Action rejects, under 35 USC § 103, claims 27 – 30, 33 – 39, 41 – 43, 45 and 46 over Forman (US 5826588) in view of Mareiro (US 6258099). These rejections are respectfully traversed.

Applicants assert that Mareiro does not qualify as a prior art reference under 35 USC § 103, as both the immediate application and Mareiro are commonly assigned to SciMed Life Systems, Inc. of Maple Grove, MN.

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 USC § 103(c).

Thus, Mareiro is not available as prior art against the immediate application.

Applicants assert that Forman does not disclose or suggest a medical balloon having a "chemically etched or ground surface," as recited in independent claim 27 and similarly recited in independent claims 30, 33 and 42.

Forman discloses a process of removing portions of balloon material by laser ablation. The Office Action admits that Forman does not disclose a process of removing a material from a balloon section by grinding or etching. Thus, the Examiner has not provided prior art references that teach or suggest all of the claim limitations.

However, in the current Office Action, the Examiner has stated, "Grinding and chemical etching are well-known processes for accurately removing material from a body." Regardless of whether chemical etching in general was known at the time of filing of the application, the examiner has not established that etching or grinding would be suitable for use in the removal of material from a balloon. Applicants do not concede that it would have been obvious to etch or grind a medical balloon. Moreover, the standard for obviousness under 35 USC § 103 is not whether it is obvious to try the recited step, but rather, whether there would be a reasonable expectation of success. See *In re Dow Chemical Co.*, 5 USPQ2d 1529 (Fed. Cir. 1988). The Examiner has not established the obviousness of trying the proposed step, let alone that there would be a reasonable likelihood of success.

Therefore, Applicants respectfully submit that independent claims 27, 30, 33 and 42 define subject matter that is patentable over the cited prior art. Claims 28, 29, 34 – 39, 41, 43, 45 and 46 depend appropriately from the aforementioned independent claims and therefore define patentable subject matter at least for the reasons stated above. Accordingly, Applicants respectfully request the withdrawal of the rejections under USC § 103.

FORMALITIES

If an extension of time is required to make this response timely and no separate petition is enclosed, Applicant hereby petitions for an extension of time sufficient to make the response timely. In the event that this response requires the payment of government fees and payment is not enclosed, please charge Deposit Account No. 22-0350.

CONCLUSION

Based on at least the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 27 – 30, 33 – 39, 41 – 43, 45 and 46 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: June 20, 2003

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